

APPENDIX D

IDENTIFICATION OF THE CLAIMS OF THE ROGERSON PATENT WHICH  
CORRESPOND TO THE PROPOSED COUNTS

A claim corresponds to a count if, considering the count as prior art, the claim would be unpatentable over the count under 35 U.S.C. §102 or 35 U.S.C. §103. MPEP §2309.2. In other words, a claim corresponds to a count if it is directed to the same patentable invention as the count. Applying this standard, all the claims (Claims 1-41) of the Rogerson Patent are believed to correspond to the proposed Counts as discussed below.

COUNT A

Claim 6 of the Rogerson Patent is the same as the second alternative of proposed Count A.

Claim 1 of the Rogerson Patent recites a bulk density of no more than  $0.2 \text{ g.cm}^{-3}$ , which is obvious in view of Claim 6. Claims 2-5 of the Rogerson Patent all depend from Claim 1 and recite optional narrower ranges of size, wall thickness and density, which fall within the ranges of Claim 1 and overlap with that of the proposed Count. Therefore, these claims also correspond to proposed Count A.

Claim 7 of the Rogerson Patent depends from Claim 1, further reciting that the microcapsules of Claim 1 are comprised predominantly of albumin. Use of such materials was well known in the art. *See, e.g.,* WO 96/32149 at page 6, lines 23-27, where such use is described. Accordingly, this claim is obvious in view of Claim 6 and defines the same patentable invention as proposed Count A.

Claims 9-12 of the Rogerson Patent all depend from Claim 1, further reciting therapeutic agents. Use of therapeutic agents in such compositions was well known to those of skill in the art. *See, e.g.,* WO 96/32149 at pages 13 and 14. Accordingly, Claims 9-12 of the Rogerson Patent define the same patentable invention as proposed Count A.

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Claims 13 and 16 of the Rogerson Patent depend from Claim 1, further describing the solubility (or lack thereof) of the composition. Particle engineering to produce particles with a desired solubility was well known in the art. *See, e.g.*, WO 97/36574 at page 5 lines 3 to 6, and WO 92/18164 at page 15 line 29 to page 16 line 2. Therefore, these claims also corresponds to proposed Count A.

Claim 14 of the Rogerson Patent is the same as the fourth alternative of proposed Count A.

Claim 15 of the Rogerson Patent depends from Claim 14, further reciting that the formulation comprises microcapsules as the predominant component. Use of such formulations was well known in the art. *See, e.g.*, WO 96/32149 at page 7 line 20 to page 8 line 18, where such use is described. Accordingly, this claim is obvious in view of Claim 14 and defines the same patentable invention as proposed Count A.

Claim 22 of the Rogerson Patent is the same as the sixth alternative of proposed Count A.

Claim 17 of the Rogerson Patent recites a bulk density of no more than  $0.2 \text{ g.cm}^{-3}$ , which is obvious in view of Claim 22. Claims 18-21 of the Rogerson Patent all depend from Claim 17 and recite optional narrower ranges of size, wall thickness and density, which fall within the ranges of Claim 17 and overlap with that of the proposed Count. Therefore, these claims also correspond to proposed Count A.

Claim 23 of the Rogerson Patent depends from Claim 17, further reciting that the microcapsules are comprised predominantly of albumin. Use of such materials was well known in the art. *See, e.g.*, WO 96/32149 at page 6, lines 23-27, where such use is described. Accordingly, this claim is obvious in view of Claim 22 and defines the same patentable invention as proposed Count A.

Claims 25-28 of the Rogerson Patent all depend from Claim 17, further reciting therapeutic agents. Use of therapeutic agents in such compositions was well known to those of skill in the art.

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*See, e.g.*, WO 96/32149 at pages 13 and 14. Accordingly, Claims 25-28 of the Rogerson Patent define the same patentable invention as proposed Count C.

Claims 29-30 of the Rogerson Patent depend from Claim 17, further describing the solubility (or lack thereof) of the composition. Particle engineering to produce particles with a desired solubility was well known in the art. *See, e.g.*, WO 97/36574 at page 5 lines 3 to 6, and WO 92/18164 at page 15 line 29 to page 16 line 2. Therefore, these claims also corresponds to proposed Count A.

Claim 36 of the Rogerson Patent is the same as the eighth alternative of proposed Count A.

Claim 31 of the Rogerson Patent recites a bulk density of no more than  $0.2 \text{ g.cm}^{-3}$ , which is obvious in view of Claim 36. Claims 32-35 of the Rogerson Patent all depend from Claim 31 and recite optional narrower ranges of size, wall thickness and density, which fall within the ranges of Claim 31 and overlap with that of the proposed Count. Therefore, these claims also correspond to proposed Count A.

Claim 37 of the Rogerson Patent depends from Claim 31, further reciting that the microcapsules are comprised predominantly of albumin. Use of such materials was well known in the art. *See, e.g.*, WO 96/32149 at page 6, lines 23-27, where such use is described. Accordingly, this claim is obvious in view of Claim 31 and defines the same patentable invention as proposed Count A.

COUNT B

Claim 8 of the Rogerson Patent is the same as the second alternative of proposed Count B.

Claim 24 of the Rogerson Patent is the same as the fourth alternative of proposed Count B.

Claim 38 of the Rogerson Patent is the same as the sixth alternative of proposed Count B.

Claim 39 of the Rogerson Patent is the same as the sixth alternative of proposed Count B.

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Claim 40 of the Rogerson Patent depends from Claim 39, further reciting specific blowing agents which is obvious in view of Claim 39 and defines the same patentable invention as proposed Count B.

Claim 41 of the Rogerson Patent depends from Claim 39, further reciting that the wall-forming material is albumin. Use of such materials was well known in the art. *See*, e.g., WO 96/32149 at page 6, lines 23-27, where such use is described. Accordingly, this claim is obvious in view of Claim 39 and defines the same patentable invention as proposed Count B.